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| APPLICATION NO.                                                                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/005,165                                                                        | 12/07/2001  | Katsunari Oji        | 040894-5395-01      | 1369             |
| 9629                                                                              | 7590        | 02/04/2005           |                     | EXAMINER         |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      | CHANG, VICTOR S     |                  |
|                                                                                   |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                   |             |                      | 1771                |                  |

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                            |                     |  |
|------------------------------|----------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>     | <b>Applicant(s)</b> |  |
|                              | 10/005,165                 | OJI ET AL.          |  |
|                              | Examiner<br>Victor S Chang | Art Unit<br>1771    |  |

~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 26 March 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 4-8 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4-8 and 17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 3/26/2004. Applicants' amendments to claims 4-8 and 17, and cancellation of claims 9-15, 18 and 19 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, in view of the newly amended claim 4 now recites, *inter alia*, noncyclic (meth)acrylamide, the rejection over JP 06-200225 is withdrawn. However, Applicants' arguments are moot in view of the new grounds of rejection made over Everaerts et al. (US 5612136) as follows.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4, 6-8 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Everaerts et al. (US 5612136).

Everaerts' invention is directed to a pressure-sensitive adhesive composition and sheet prepared therefrom which has excellent ability to adhere to acidic surfaces such as acid-rain resistant automotive paints. The adhesive comprises a crosslinked

copolymer 100 parts by weight of monomers comprising about 60 to about 90 parts by weight (meth)acrylate esters, about 40 to about 10 parts by weight nitrogen containing basic monomers, 0-3 parts optional copolymerizable acidic monomer, and about 0.05 to about 1 percent by weight crosslinker (Abstract and column 24, line 51 to column 25, line 45). Respectively, (meth)acrylate esters include butyl(meth)acrylate, etc. (column 25, lines 46-51); nitrogen containing basic monomers include N,N-dimethyl(meth)acrylamide, etc. (column 25, lines 56-60); and acidic monomers include ethylenically unsaturated carboxylic acids, acrylic acid, etc. (column 25, line 66 to column 25, line 4). Further, suitable substrate sheet materials include polyesters, silicones, etc. (column 26, lines 15-19).

For claims 4, 6-8 and 17, although Everaerts is silent about the water vapor permeability of the plastic film substrate, it is noted that Everaerts' polyester substrate is essentially the same film substrate as the instant invention (see paragraph [0041]), and it is believed that the water vapor permeability is inherent to a polyester film. As such, Everaerts clearly anticipates the invention as claimed.

Claims lack novelty.

#### ***Claim Rejections - 35 USC § 103***

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al. (US 5612136).

Everaerts's teachings are again relied upon as set forth above.

For claim 5, although Everaerts is silent about the gel content of the adhesive, it is noted that Everaerts expressly teaches that it is known art that improvement in internal or cohesive strength (i.e., shear strength), which are often required to resist the severe environmental and chemical conditions found in automotive applications, can be obtained through crosslinking the acrylate PSAs (column 1, lines 45-49). Further, Everaerts expressly teaches that the adhesive copolymer comprises about 0.05 to about 1 percent by weight crosslinker as set forth above. As such, it is believed that the amount of crosslinking (which is commonly measure as gel content) is either inherently disclosed by Everaerts, or an obvious optimization to one of ordinary skill in the art of pressure sensitive <sup>adhesive</sup>, motivated by the desire to obtain an improved cohesive strength and required resistance to environmental conditions.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300  
1700

*Daniel Zirker*